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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,707	02/23/2004	Paul F. Manley	MANL.00001	1457

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EXAMINER	
KUHNS, SARAH LOUISE	
ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/784,707	MANLEY, PAUL F.	
	Examiner	Art Unit	
	Sarah L Kuhns	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-22 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites a "substantially water-intolerant coating" and there is no support for this requirement in the specification.

Claim Rejections - 35 USC § 103

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being obvious/unpatentable over Nakanishi, Food Packag. (Jpn), and Shigeo, JP 55034966 A, in view of Cone, U.S. Patent 5,229,149, Waters, U.S. Patent 6,376,000, Macpherson, U.S. Patent 5,017,394, Stewart, U.S. Patent 6,616,958, and the applicant's admission of the prior art.

In regard to claim 1, Nakanishi discloses a method of decorating fruit with a design, comprising of selecting a fruit, selecting a design, printing the design, and attaching the design to the fruit (translation, page 17), as further evidenced by Shigeo (translation, page 2). Nakanishi does not expressly disclose the coating of the fruit with

an edible coating. It was conventional in the art to provide coated fruit as evidenced by Cone (column 4, line 52) and the applicant's admission of prior art. To modify Nakanishi and print on a conventional coated fruit, rather than a conventional uncoated fruit, would have been an obvious matter of choice since Nakanishi teaches the general process of printing on fruit and coating the fruit could increase consumer appeal and enhance taste.

Also, it was well known in the art to attach designs to substantially water-intolerant substances, as evidenced by Waters (abstract). Since it was known to coat fruit with substantially water-intolerant substances as taught by Cone, and also to print on such substances as taught by Waters, it would have been obvious to print on coated fruit to add to the attractiveness of the product.

In regard to claim 2, Waters (column 6, line 42) and the applicant's admission of prior art both teach the use of an edible sheet for use in decorating chocolates. To extend this method to printing on coated fruit would have been obvious, in view of Nakanishi and Shigeo, in order to make the fruit more pleasing to the consumer's eye.

In regard to claim 3, it would have been expected by one skilled in the art that the color of the frosting sheet match the color of the coating. There is nothing in the claims suggesting the colors would be different.

In regard to claim 4, Waters (column 6, line 49) and the applicant's admission of the prior art disclose the use of an inkjet printer for printing designs onto edible sheets. To use this method to print designs for coated fruit would be obvious, in view of

Nakanishi and Shigeo, to provide a quick way of printing and designs and an easy way to reproduce designs without changing the consistency of the coating.

In regard to claims 5 and 6, Stewart (column 10, line 41) teaches the use of an edible film for decorating foodstuff. A design is printed on the film, which has a peelable backing. This use of an edible film would have been obvious to extend to the decoration of fruit, to make the fruit more pleasing to the eye. Also, the pre-printed design and peelable backing would make it easier to apply the design and further decorate the fruit.

In regard to 7, Waters (column 8, line 9) teaches the use of a backing (for edible paper) made of wax paper or plastic, which includes materials made from acetate. Therefore, it would have been obvious to choose acetate as the material for the backing of the film so that the backing would peel off easily while the edible film adhered to the fruit adding the art printed thereon.

In regard to claims 8-16, 21, and 22, the applicant's admission of prior art discloses that it is well known in the field to use chocolate coatings and films. Edible films made of chocolate are commercially available and it is well known in the field that chocolate products can be made with different flavors. Using a film or coating made of caramel would have been obvious in order to provide another flavor and more options for the consumer. In addition, the prior art discloses that strawberries are commonly coated and decorated, and it would be obvious to extend this to other fruits for greater variety for the consumer.

In regard to claims 17 and 18, Nakanishi teaches that edible films can be attached to foodstuff by either moistening the film or using an adhesive (Table 5). As such, it would be obvious to attach a design to a fruit while the coating is still wet, and also, to use an adhesive in attaching, to achieve better adhesion between the design and the fruit.

In regard to claim 19, Waters (column 6, line 42) and the applicant's admission of prior art teach the selecting of a foodstuff, the selecting of a design to decorate a foodstuff, the printing of the design on an edible sheet, and the attaching of the edible sheet to foodstuff. It would be obvious to extend this method to fruit, in view of Nakanishi and Shigeo, in order to provide decorative fruit that would be pleasing to the consumer's eye.

In regard to claim 20, Stewart (column 10, line 41) and the applicant's admission of prior art teach the selecting of a foodstuff, the selecting of a design to decorate a foodstuff, the printing of the design on an edible film with a peelable backing, and the attaching of the edible film to foodstuff. It would be obvious to extend this method to fruit, in view of Nakanishi and Shigeo, in order to provide decorative fruit that would be pleasing to the consumer's eye.

Response to Arguments

With regard to applicant's arguments regarding the prior art not teaching the limitation now claimed, i.e. a water-intolerant coating, it should be noted that the prior art

has been applied above to show this limitation. Therefore, applicant's arguments are moot in view of the newly applied combination of references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah L. Kuhns whose telephone number is 571-272-1088. The examiner can normally be reached on Monday - Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLK

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